



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF APPEALS

18th AF

Assignee's Docket No.: 8963.00)
Group Art Unit: 3693)
Serial No.: 09/826,612)
Examiner: Daniel S. Felten)
Filing Date: April 5, 2001)
Title: Self-Service Terminal)

APPEAL BRIEF

A Summary of Argument (3 Pages) Begins on Page 5

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Gregory A. Welte

1. REAL PARTY IN INTEREST

NCR Corporation.

2. RELATED APPEALS AND INTERFERENCES

None.

3. STATUS OF CLAIMS

Claims 1, 2, 8 and 21 - 25 are pending, rejected, and appealed.

09/826,612
Art Unit 3693
Docket 8963.00

The remaining claims, namely, 3 - 7 and 9 - 20, have been cancelled.

4. STATUS OF AMENDMENTS

No Amendment-After-Final has been submitted.

5. SUMMARY OF CLAIMED SUBJECT MATTER

One type of ATM, Automated Teller Machine, offers access to the Internet, to allow an ATM customer to visit a merchant's web site, to make purchases. (Specification, page 1, lines 1 - 10; page 6, lines 14 - 18; ATMs 12a - 12d in Figure 1; page 7, lines 1 - 4.)

Ordinarily, in a web-site purchase, the customer would use a credit card to pay for the purchase. The credit card company would pay the web site (ie, the merchant), and the payment would be charged to the customer's monthly credit card bill. (Specification, page 1, lines 10 - 14 and 18 - 20.)

However, under the invention, the ATM customer pays the ATM for the purchase, and **does not pay the merchant**. The ATM then pays the merchant, using the ATM's own resources, such as a credit card owned by the ATM. (Specification, page 1, line 27 - page 2, line 4; page 2, lines 20 - 22; page 10, lines 12 - 21.)

This arrangement produces two desirable results:

-- The identity of the ATM customer is not

09/826,612
Art Unit 3693
Docket 8963.00

necessarily disclosed to the merchant.

-- No credit card number of the ATM customer
disclosed to the merchant.

(Specification, page 1, lines 18 - 20; page 2, lines 8 - 10.)

Further, the invention allows the ATM customer to make purchases over the Internet, even if the customer lacks a credit card, or any means of making electronic payments. The customer can pay cash to the ATM, which then pays for a purchase using the ATM's credit card. (Specification, page 5, last three lines; page 11, lines 11 - 14.)

Mapping of Claim Elements in Independent Claims

Parenthetical phrases, in **bold typeface**, are inserted into the following independent claim 1, to identify matter in the Specification and Figures which supports the claim language which is adjacent said **bold, parenthetical typeface**.

1. A self-service terminal which comprises an Automated Teller Machine, ATM, and which is operated by an operating party, for connection to a network (**ATM 12, Figure 1; page 6, lines 14 - 18**), the terminal comprising:

a) means for receiving payment from a user, including payment wherein the user selectively pays via cash, credit card, electronic card, or debit card (**page 7**,

09/826,612
Art Unit 3693
Docket 8963.00

lines 10 - 12; modules 58 and 60, Figure 2); and

b) means for delivering a third party payment to a third party or merchant (browser 84, Figure 2; ATM application 82, Figure 2; page 10, lines 19 - 24; blocks 126, 128, Figure 4), who is different from the user and different from the operating party, which third party payment

- i) is made using a credit card assigned to the terminal (page 10, lines 19, 20),
- ii) does not allow the third party to learn the identity of the user (page 11, lines 11 - 14; page 2, lines 5 -10), and
- iii) does not allow the third party to learn an account number of the user (page 11, lines 11 - 14; page 2, lines 5 -10).

6. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The rejection of claims 1, 2, 8, and 21 - 25 as obvious under 35 USC § 103, based on Barcelou and Flenley.

7. ARGUMENT

All claims were rejected as obvious, based on Barcelou and Flenley.

09/826,612
Art Unit 3693
Docket 8963.00

SUMMARY OF ARGUMENT

Point 1

The Final Action has not shown, nor attempted to show, claim 1(b) in the references. This fact, by itself, is sufficient to defeat the rejection.

Point 2

Claim 1 recites two payments:

- 1) payment from a customer to an ATM
- and
- 2) payment by the ATM to a seller.

At best, Barcelou shows a single payment, namely, that by a customer. The claimed two payments have not been shown in the references.

Point 3

Claim 1 states that payment for a purchase is made by a credit card assigned to an ATM (which is a machine). No credit card assigned to an ATM has been shown in the references.

Point 4

Claim 1(b) states that the seller does not learn an account number of the user of the ATM. This makes sense: the ATM uses **its own credit card** to pay the seller.

09/826,612
Art Unit 3693
Docket 8963.00

That is directly contrary to Barcelou, who states (column 4, line 27 et seq.) that **the user** of an ATM pays for a purchase using **the user's credit card**.

Plainly, the seller in Barcelou learns the account number of the credit card. If the seller did not, then the seller could not request a charge against the credit card.

Barcelou is contrary to the claim.

Point 5

Claim 1 states that a payment is made to a "third party" who is different from

- 1) the purchaser (eg, the ATM customer)
and
2) the operator of the ATM.

Also, the third party does not learn an "account number" of the purchaser.

In Barcelou, two interpretations are possible.

ONE - a **single** vending-machine-ATM makes a sale, and receives payment. In this case, no "third party" is present, contrary to claim 1.

TWO - a third party may be present, but he receives a credit card number. Thus, the third party learns the "account number" of the purchaser, contrary to claim 1.

09/826,612
Art Unit 3693
Docket 8963.00

Both interpretations are contrary to claim 1.

Point 6

The Flenley reference describes ordinary credit card transactions, wherein the seller learns a credit card number, and identity, of a purchaser. That is contrary to claim 1, and teaches against combining the references. No explanation overcoming this contrary teaching has been given.

Point 7

No valid teaching has been given for combining the references. The rationale given is that it is obvious to substitute Flenley's well known Internet browser for Barcelou's touchscreen, on the grounds that the browser is an "alternative" to a touchscreen.

This rationale is factually incorrect on its face. A "browser" is not an "alternative" to a "touchscreen." They perform completely different functions, for different purposes.

This Brief gives further explanation of why this rationale is insufficient.

Point 8

These Points apply to the remaining claims.

END SUMMARY

09/826,612
Art Unit 3693
Docket 8963.00

ARGUMENT IN FULL

Barcelou Reference

Barcelou combines an ATM with a vending machine, in a single kiosk. He intends to include all types of vending machines imaginable. (See column 3, line 30 et seq.)

Barcelou indicates that, if the user presents a credit card at the kiosk, the credit card information is transmitted to a merchant. Barcelou gives the example of purchasing gasoline using a credit card. (Column 5, lines 21 - 24.) Plainly, the gas station relays the credit card information to a central office which manages the gas station, or at least which handles payment for the gas station.

Applicant points out that, in Barcelou's system, the identity of the credit card user **IS DISCLOSED** to the seller. For example, the undersigned attorney frequently purchases lumber and tools from a specific home center, using a credit card. Each time, the home center prints a receipt bearing the name of the undersigned attorney. This name is clearly derived from the mag-stripe on the credit card, or from the credit card company based on the account number read from the mag-stripe, a combination of these two sources, or in some other way, based on the credit card.

Thus, in an ordinary credit card transaction, as in Barcelou, the identity of the purchaser is disclosed to the seller.

Under one form of the invention, the identity is not

09/826,612
Art Unit 3693
Docket 8963.00

disclosed: the purchaser remains anonymous. (See Specification, page 2, lines 12, 13 and lines 8, 9.)

Flenley Reference

Flenley is cited solely for the purpose of showing an ATM which contains a browser for browsing the Internet.

Analysis of Rejections

Claim 1

Claim 1 recites:

1. A self-service terminal which comprises an Automated Teller Machine, ATM, and which is operated by an operating party, for connection to a network, the terminal comprising:

a) means for receiving payment from a user, including payment wherein the user selectively pays via cash, credit card, electronic card, or debit card; and

b) means for delivering a third party payment to a third party or merchant, who is different from the user and different from the operating party, which third party payment

i) is made using a credit card assigned to the terminal,

ii) does not allow the third party to learn the identity of the user, and

iii) does not allow the third party to learn an account number of the user.

09/826,612
Art Unit 3693
Docket 8963.00

POINT 1

The Final Office Action has not even attempted to show all of claim 1(b) in the references.

The only possible attempt lies in the second full paragraph on page 4, which begins "--an electronic payment mechanism. . ." However, the language in that attempt does not correspond to claim 1(b).

Thus, the Final Action has not shown, nor attempted to show, claim 1(b) [including sub-paragraphs (i) through (iii)] in the applied references.

MPEP § 2143.03 states:

To establish prima facie obviousness . . . all the **claim limitations** must be taught or suggested by the prior art.

POINT 2

Claim 1 recites two "payments:"

- 1) a payment from an ATM customer to an ATM and
- 2) a payment by the ATM to a seller.

To repeat:

- Claim 1(a) recites means for receiving payment A from the user of the ATM,
- Claim 1(b) recites means for delivering a

09/826,612
Art Unit 3693
Docket 8963.00

payment B from the ATM to a third party (who sells something to the ATM user).

Those two "payments" have not been shown in the applied references.

Only a **single** "payment" has been shown in Barcelou, namely, receipt of cash from a customer for a purchase. But the claimed "payment" by the ATM is absent.

POINT 3

Regarding payment to the third party (who sells something to the user), claim 1(b) states that the payment is made using a credit card assigned to the terminal/ATM.

That has not been shown in the applied references.

To repeat: no credit card assigned to an ATM has been shown in the references.

POINT 4

Claim 1(b) states that the third party (the seller) does not learn an account number of the user of the ATM. This makes sense: the ATM uses **its own credit card** to pay the seller.

That is directly contrary to Barcelou, who states (column 4, line 27 et seq.) that **the user** of Barcelou's ATM pays for a purchase using a credit card.

Plainly, the recipient (or seller) of the payment in Barcelou

09/826,612
Art Unit 3693
Docket 8963.00

learns the account number of the credit card. If the recipient-seller did not, then the recipient-seller could not request a charge against the credit card.

Therefore, in Barcelou, the seller learns the credit card number of the user of the ATM. That is contrary to claim 1(b). Further, this fact teaches directly against the invention.

POINT 5

Claim 1 states that a payment is made to a "third party" who is different from the purchaser and the operator of the ATM.

Two interpretations of Barcelou seem possible. It will be shown that neither interpretation shows the claim elements in question.

INTERPRETATION 1

As stated above, Barcelou shows a combination ATM-and-vending-machine. Barcelou appears to state that the operator of the ATM is also the party who sells items to the user of the combined ATM/vending machine. (Column 4, lines 14 - 26, for example.) In this case, no "third party" is present, as in claim 1. Thus, this claim element is missing.

Further, if no "third party" is present, then the operator of Barcelou's ATM obtains the payment information, such as a credit card number, from the user of the ATM. That is contrary to claim

09/826,612
Art Unit 3693
Docket 8963.00

1.

Further still, if the ATM operator is the seller, then it makes no sense to say that a credit card is assigned to the ATM, as in claim 1(b)(i). The reason is that the ATM, in essence, is using the credit card to pay itself.

Restated: if you owned the ATM-vending-machine of Barcelou, why would you assign a credit card to that machine, to pay yourself for purchases made by a customer ?

Therefore, under this interpretation, claim 1 is not found in Barcelou.

INTERPRETATION 2

Barcelou states:

FIG. 3b illustrates a combined ATM and Internet retail terminal . . .

(Column 4, lines 42, 43.)

This may imply a "third party," namely, something on the Internet which is contacted by the "terminal."

However, Barcelou discusses no approach to making payment to the supposed third party, apart from the discussion at column 4, line 27 et seq. But that discussion merely refers to an ordinary credit card transaction, or similar, wherein the user of Barcelou's ATM provides a credit card number to the third-party seller.

09/826,612
Art Unit 3693
Docket 8963.00

Therefore, under this interpretation, the third-party seller obtains a credit card number, contrary to claim 1.

SUMMARY OF TWO INTERPRETATIONS

Under Interpretation 1, no "third party" is present in Barcelou, as claimed, so claim 1 is not shown for that reason.

Under Interpretation 2, if a "third party" **IS PRESENT**, the user in Barcelou deals directly with the "third party." That party obtains a credit card number, contrary to claim 1.

Further, in the latter situation:

-- There is no "credit card assigned to the terminal" as in claim 1(b)(i).

-- The recitation that the "third party payment . . . does not allow the third party to learn the identity of the user" is not found. (Claim 1(b)(ii).)

POINT 6

The Final Office Action, page 3, lines 3 - 7, states that Barcelou shows a browser which allows a user to visit web sites, but not make purchases. Flenley is cited as showing a browser at an ATM for making purchases on the Internet.

However, Flenley, column 5, lines 48 - 60, describes Internet purchases, in which the ATM customer uses a credit card in the usual manner. (Line 55.) That is directly contrary to claim 1(b),

09/826,612
Art Unit 3693
Docket 8963.00

which states that the seller ("third party") does not learn

-- an "account number" of the customer,

nor

-- the "identity" of the customer.

Thus, even if Flenley is combined with Barcelou, claim 1(b) is not attained.

POINT 7

POINT 7A

No valid teaching has been given for combining the references.

Two rationales are given: (1) page 3, first paragraph, last two sentences, and (2) page 5, first full paragraph. They are essentially identical.

They merely state that it is obvious to substitute Flenley's well known Internet browser for Barcelou's touchscreen, on the grounds that the browser is an "alternative" to a touchscreen.

That is not a teaching under section 103. That is a naked conclusion.

Further, special rules apply to substitution of known equivalents. MPEP § 2144.06 states:

In order to rely on equivalence as a rationale supporting an obviousness rejection, the equivalency must be recognized in the prior art, and cannot be based on . . . the mere fact that the components at issue are functional or mechanical equivalents.

09/826,612
Art Unit 3693
Docket 8963.00

No "recognition" of equivalence in the prior art has been shown.

Further still, it is self-evident that a touch screen is not an "alternative" to a browser, as the Final Action asserts.

-- A "touch screen" acts as push-buttons for a user to make selections, but without the mechanical motion of push-buttons.

-- A "browser" is software which sends requests to URLs on the Internet. A "URL" (Uniform Resource Locator) is an address of a computer or computer system on the Internet.

The Internet delivers the requests to the computers located at the URL. The computers respond by sending data which was requested.

The Final Action is factually incorrect: a "touch screen" is not an "alternative" to a "browser." The rationale is invalid.

POINT 7B

The Final Action's rationale does not, as a matter of logic, lead to the claimed invention.

The rationale is that

. . . [Flenley's] well known Internet browser [is] an alternative to Barcelou's touchscreen

09/826,612
Art Unit 3693
Docket 8963.00

to provide viewing and selection of various goods and services.

(Final Action, page 5, end of first full paragraph.)

However, Flenley's browser, **by itself**, provides those results ("viewing and selection" on the Internet).

That is, if you want "viewing and selection," then simply follow Flenley's teachings of using a browser at an ATM. There is no reason to add Flenley's browser to Barcelou.

CONCLUSIONS AS TO CLAIM 1

Several elements of claim 1 are not found in the references, even if combined.

No valid teaching has been given.

Claim 8

The discussion of claim 1 applies to claim 8, as do the following Points.

POINT 1

Claim 8 recites a self service terminal which allows a customer to make purchases over a network, using a credit card.

Claim 8 states that the credit card payment

- i) prevents the merchant from learning

09/826,612
Art Unit 3693
Docket 8963.00

identity of the user and
ii) prevents the merchant from learning the
first credit card number.

Neither (i) nor (ii) have been shown in the combined references.

The Final Action, bottom of page 5, appears to cite Barcelou, column 4, line 66 - column 5, line 12, as showing this, because of the Final Action's previous citation of this passage.

However, this passage of Barcelou merely refers briefly to components in Barcelou's Figure 5, including

safe 55,
bill dispenser 54,
bill acceptor 52 or 53,
smart card safe 47,
smart card dispenser 46,
motion sensor 59,
printer 57, and
receipt dispenser 56.

But none of this shows the claimed elements of (1) keeping identity of a customer from a merchant nor (2) keeping a credit card number of a customer from a merchant.

POINT 2

Claim 8 states that a credit card number is obtained from a

09/826,612
Art Unit 3693
Docket 8963.00

customer of the terminal. Claim 8 then states:

c) transmitting payment to the merchant via an account number which is different from the first credit card number . . .

Thus, **two numbers** are recited: (1) the credit card number and (2) the "account number which is different."

The Final Action fails to show these two "numbers."

Claim 21

The discussion of claim 1 applies to claim 21, as does the following.

Claim 21 recites using an ATM to make a purchase using a browser. Claim 21 then states:

b) receiving payment via a first credit card from the user for a purchase from a selected merchant; and

c) using a credit card account assigned to the ATM, transmitting payment to the selected merchant.

No "credit card assigned to the ATM" has been shown in the references.

Nor has the use of such a credit card for transmitting payment to a merchant been shown.

09/826,612
Art Unit 3693
Docket 8963.00

Claim 22

The discussion above applies to claim 22, as does the following.

Claim 22 depends from claim 21, and states that

- the identity of the user is not disclosed to the merchant,
- no account number of the user is disclosed to the merchant.

Neither of those recitations have been shown in the applied references.

Claim 23

The discussion above applies to claim 23, as does the following.

Claim 23 depends from claim 1, and states: "no account number of the user is disclosed to the third party."

This has not been shown in the applied references.

Claim 24

The discussion above applies to claim 24, as does the following.

Claim 24 depends from claim 23, and states:

. . . the credit card of the terminal has an account number T, and no account number of the

09/826,612
Art Unit 3693
Docket 8963.00

user is identical with account number T.

The account number T has not been shown in the references.
Nor has a non-identical account number of the user been shown.

Claim 25

The discussion above applies to claim 25, as does the following.

Claim 25 depends from claim 21, and states that the terminal has a credit card number. That has not been shown in the applied references.

CONCLUSION

Appellant requests that the Board reverse all rejections, and pass all claims to issue.

Respectfully submitted,


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ATTACHMENTS: -- CLAIMS APPENDIX,
 -- STATEMENT THAT NO EVIDENCE APPENDIX IS ATTACHED,
 and
 -- STATEMENT THAT NO RELATED PROCEEDINGS APPENDIX
 IS ATTACHED

8. CLAIMS APPENDIX

1. A self-service terminal which comprises an Automated Teller Machine, ATM, and which is operated by an operating party, for connection to a network, the terminal comprising:

- a) means for receiving payment from a user, including payment wherein the user selectively pays via cash, credit card, electronic card, or debit card; and
- b) means for delivering a third party payment to a third party or merchant, who is different from the user and different from the operating party, which third party payment
 - i) is made using a credit card assigned to the terminal,
 - ii) does not allow the third party to learn the identity of the user, and
 - iii) does not allow the third party to learn an account number of the user.

2. A terminal according to claim 1, further comprising a browser for enabling a user to browse sites on the network to select an item for purchasing from a merchant.

8. A method of operating self-service terminals in a

09/826,612
Art Unit 3693
Docket 8963.00

self-service terminal network, the method comprising the steps of:

- a) at a self-service terminal, providing a user with a browser for browsing through merchants connected to the network, wherein each merchant offers one or more items for purchase;
- b) receiving payment via a first credit card number from a user for a selected item to be purchased from a merchant;
- c) transmitting payment to the merchant via an account number which is different from the first credit card number, which payment
 - i) prevents the merchant from learning identity of the user and
 - ii) prevents the merchant from learning the first credit card number.

21. A method of purchasing items using an Automated Teller Machine, ATM, comprising the steps of:

- a) providing a web browser to a user of the ATM for browsing web pages of merchants;
- b) receiving payment via a first credit card from the user for a purchase from a selected merchant; and
- c) using a credit card account assigned to the ATM, transmitting payment to the selected merchant.

22. Method according to claim 21, and further comprising:

d) using the account to make payment to the selected merchant

(i) without identifying the user to the merchant, and

(ii) without disclosing an account number of the user to the merchant.

23. Terminal according to claim 1, in which the user makes payment using (1) a credit card having an account number or (2) an account having an account number and no account number of the user is disclosed to the third party.

24. Terminal according to claim 23, in which the credit card of the terminal has an account number T, and no account number of the user is identical with account number T.

25. Terminal according to claim 8, in which the account number which is different from the first credit card number represents a credit account of the terminal.

09/826,612
Art Unit 3693
Docket 8963.00

9. EVIDENCE APPENDIX

None.

09/826,612
Art Unit 3693
Docket 8963.00

10. RELATED PROCEEDINGS APPENDIX

None.